

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Appellant: **Jonathan I. McCormack, et al.**

Case: **1217 (TVW/APP 33 US)**

Serial No.: **09/977,085** Filed: **10/12/01**

Examiner: **Won, Michael Young** Group Art Unit: **2155**

Title: **SYSTEM METHOD AND APPARATUS FOR PORTABLE
DIGITAL IDENTITY**

Confirmation #: **1923**

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Commissioner for Patents
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SIR:

APPEAL BRIEF

Appellants submit this Appeal Brief to the Board of Patent Appeals and Interferences on appeal from the decision of the Examiner of Group Art Unit 2155 dated May 8, 2006 finally rejecting claims 15-27.

In the event that an extension of time is required for this appeal brief to be considered timely, and a petition therefor does not otherwise accompany this appeal brief, any necessary extension of time is hereby petitioned for.

The Commissioner is authorized to charge the Appeal Brief fee (\$500) and any other fees due to make this filing timely and complete (including extension of time fees) to Deposit Account No. 20-0782/TVW/APP33US.

Table of Contents

1.	Identification Page.....	1
2.	Table of Contents	2
3.	Real Party in Interest	3
4.	Related Appeals and Interferences	4
5.	Status of Claims	5
6.	Status of Amendments	6
7.	Summary of Claimed Subject Matter	7
8.	Grounds of Rejection to be Reviewed on Appeal	9
9.	Arguments	10
10.	Conclusion	15
11.	Claims Appendix	16
12.	Evidence Appendix	19
13.	Related Proceedings Appendix	20

Real Party in Interest

The real party in interest is TVWORKS, LLC

Related Appeals and Interferences

Appellants assert that no appeals or interferences are known to Appellants, Appellants' legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

Status of Claims

Claims 15-27 are pending in the application. Claim 1 was originally presented in the application. Claims 2-27 were added by amendment. Claims 1-14 have been canceled without prejudice. Claims 15-27 stand finally rejected as discussed below. The final rejection of claims 15-27 is appealed.

Status of Amendments

All claim amendments have been entered.

Summary of Claimed Subject Matter

Embodiments of the present invention generally are directed to a system for a portable digital identity. A portable digital identity follows a user wherever the user may go providing the user with the same electronic environment accessible from any electronic communication device. (See Appellants' specification, p. 4, ll. 8-10). The digital identity includes email preferences, TV preferences and preferred credit card and shipping information. (See *Id.* at ll. 17-24). The system of the present invention comprises a database, a command server and a digital identity server.

For the convenience of the Board of Patent Appeals and Interferences, Appellants' independent claim 15 is presented below in claim format with elements read on the various figures of the drawings and appropriate citations to at least one portion of the specification for each element of the appealed claims.

Claim 15 recites (with reference numerals, where applicable and cites to at least one portion of the specification added):

15. A system, comprising:

a database (236) for storing a digital identity (FIG. 8) for each of at least two user devices (204, 206, 208) and providing access to the digital identities, wherein one of the user devices (204, 206, 208) is a DTV client (204, 206) (p. 13, ll. 19-21);

a command server (238) for storing a plurality of configuration information about each user device and providing access to the configuration information (p. 9, ll. 8-20; p. 13, ll. 17-19); and

a digital identity server (210) coupled to the database (236) and the command server (238) and including at least two adapters (222, 224, 226) for at least two types of user device (204, 206, 208), each adapter (222, 224, 226) associated with one of the types of user devices (204, 206, 208), the adapters (222, 224, 226) for storing a plurality of digital identity data associated with each digital identity, providing access to the digital identity data, and interfacing with each user device (204, 206, 208), the

digital identity server (210) configured for receiving a request from a particular user device (204, 206, 208) via one of the adapters (222, 224, 226), accessing the digital identity for the particular user device (204, 206, 208) from the database (236), accessing the configuration information about the particular user device (204, 206, 208) from the command server (238), applying the configuration information to filter the digital identity, and providing the filtered digital identity to that user device (204, 206, 208) via one of the adapters (222, 224, 226) (p. 9, ll. 8-11; p. 13, ll. 6-16).

Grounds of Rejection to be Reviewed on Appeal

Claims 15-19 and 23-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Jiang, et al. (U.S. Patent No. 6,741,853B1, hereinafter "Jiang") in view of Kessler, et al. (U.S. Patent No. 6,621,528B1, hereinafter "Kessler").

Claims 20-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Jiang and Kessler and in further view of Desrochers (U.S. Patent No. 6,553,405, hereinafter "Desrochers").

Claims 26 and 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over Jiang and Kessler and in further view of Jindal, et al. (U.S. Patent No. 6,092,178, hereinafter "Jindal").

ARGUMENTS

I. THE EXAMINER ERRED IN REJECTING CLAIMS 15-27 UNDER 35 U.S.C. §103(a) BECAUSE 1) THERE IS NO MOTIVATION OR SUGGESTION TO COMBINE JIANG AND KESSLER 2) THERE IS NO REASONABLE EXPECTATION OF SUCCESS IN THE COMBINATION OF JIANG AND KESSLER AND 3) THE CITED REFERENCES FAIL TO TEACH OR TO SUGGEST DIGITAL IDENTITIES.

A. 35. U.S.C. §103(a) – Claims 15-19 and 23-25

Claims 15-19 and 23-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Jiang in view of Kessler. Appeal of this rejection is requested.

According to MPEP §2143, to establish a *prima facie* case of obviousness under §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Appellants respectfully submit that there is no suggestion or motivation to combine Jiang and Kessler. The Examiner attempts to use impermissible hindsight to combine the teachings of Jiang and Kessler. Jiang teaches a device aware internet portal for providing services such as voice mail, e-mail, personal information management and internet access services. (See Jiang, col. 6, ll. 51-64) Kessler teaches a channel control for digital television. (See Kessler, Abstract) The Appellants respectfully submit that there is no television set in Jiang to be modified to include the DTV control system of Kessler.

The Examiner alleges that Jiang provides motivation. Specifically, the Examiner alleges “even though Jiang does not explicitly teach of [sic] televisions, Jiang teaches that the system is a scalable platform, allowing value added services to be added without hardware and software restructuring . . . open interfaces to wireless and wireline networks allow service providers to integrate service offerings as networks and technologies evolve.” (See Advisory Action dated August 17, 2006, p. 5, ll. 9-14, emphasis in original)

The Appellants submit that a reasonable interpretation of the cited section of Jiang would allow additional service offerings, as emphasized by the Examiner, but only service offerings consistent with the overall teachings of Jiang, such as other types of messaging services. Jiang simply does not provide support to interpret the cited section to include unrelated technologies such as cable television services and DTV control systems as taught by Kessler.

Even if the Examiner’s allegation of motivation or suggestion to combine Jiang and Kessler is maintained, Jiang and Kessler fail to provide a reasonable expectation of success. As discussed above, Jiang and Kessler teach completely unrelated technologies. Jiang teaches device dependent delivery of data such as location based services, also known as smart push messaging. (See Jiang, col. 15, l. 45 – col. 18, l. 19) Kessler only teaches a DTV control system for tuning digital television for digital video broadcast format video. (See Kessler, Abstract) Nowhere does Kessler teach that the DTV control system is capable of controlling any of the services offered by Jiang. Conversely, Jiang fails to teach or suggest how any of the services offered by Jiang could be implemented in a DTV control system. Therefore, the reasonable expectation of success is completely absent from the prior art.

Moreover, the combination of Jiang and Kessler fails to teach or to suggest all of the claim limitations. Specifically, Jiang and Kessler fail to teach a database for storing a digital identity or a digital identity server coupled to the database and a command server for providing access to the digital identity data. As discussed in the summary of claimed subject matter above, the Appellants’ specification teaches that digital identity data follows a user wherever the user

may go thereby providing the user with the same electronic environment accessible from any electronic communication device. (See Appellants' specification, p. 4, ll. 8-10) The digital identity includes email preferences, TV preferences and preferred credit card and shipping information. (See *Id.* at ll. 17-24) Digital identity data may further include a user's favorites data such as a list of favorite applications and favorite internet sites. (See Appellants' specification, p. 9, ll. 1-4)

In contrast, Jiang only teaches storing user information. (See Jiang, col. 9, ll. 26-30) The Appellants respectfully submit that user information is not the same as digital identity data. Jiang teaches that user information is only information required to authorize a user. (See Jiang, col. 11, ll. 48-54) For example the user information includes the user's names, user's addresses, user's e-mail addresses, user's role, user identification and user password. (See *Id.*) Moreover, unlike the Appellants' invention that teaches a portable digital identity, Jiang only teaches a method for providing information to devices in a format preferable to a device type. (See Jiang, Abstract).

Kessler fails to bridge the substantial gap left by Jiang because Kessler only teaches a DTV control system for tuning a digital television for digital video broadcast format video. (See Kessler, Abstract). Thus, the combination of Jiang and Kessler fails to teach all of the Appellants' claim limitations.

Therefore, Appellants submit that claim 1 is not obvious under 35 U.S.C. §103 and is patentable over Jiang and Kessler because there is no suggestion or motivation to combine the references, there is no reasonable expectation of success from combining Jiang and Kessler and the combination of Jiang and Kessler fail to teach or to suggest all of the limitations found in independent claim 1. Furthermore, claims 16-19 and 23-25 depend from independent claim 1 and recite additional limitations. As such, and for at least the same reasons as discussed above, Appellants submit that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable. Therefore, Appellants respectfully request that this rejection under 35 U.S.C. §103(a) be withdrawn.

B. 35. U.S.C. §103(a) – Claims 20-22

Claims 20-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Jiang and Kessler and in further view of Desrochers. Appeal of this rejection is requested.

Claims 20-22 depend from independent claim 15 and recite additional limitations thereof. Moreover, for at least the reasons discussed above, the Jiang and Kessler references cannot be reasonably combined and when combined, fail to teach or suggest Appellants' invention as a whole, as recited in claim 15. Desrochers also does not teach or suggest at least “a database for storing a digital identity or a digital identity server coupled to the database and a command server for providing access to the digital identity data.” Accordingly, any attempted combination of Jiang and Kessler with Desrochers, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to independent claim 15 because Jiang and Kessler cannot be meaningfully combined and they all lack the feature of a database for storing a digital identity or a digital identity server coupled to the database and a command server for providing access to the digital identity data. As such, Appellants submit that dependent claims 20-22 are also not obvious and are patentable under 35 U.S.C. §103.

Therefore, Appellants respectfully request that this rejection under 35 U.S.C. §103(a) be withdrawn.

C. 35. U.S.C. §103(a) – Claims 26 and 27

Claims 26 and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Jiang and Kessler and in further view of Jindal. Appeal of this rejection is requested.

Claims 26 and 27 depend from independent claim 15 and recite additional limitations thereof. Moreover, for at least the reasons discussed above, the Jiang and Kessler references cannot be reasonably combined and when combined, fail to teach or suggest Appellants' invention as a whole, as recited in claim 15.

Jindal also does not teach or suggest at least “a database for storing a digital identity or a digital identity server coupled to the database and a command server for providing access to the digital identity data.” Accordingly, any attempted combination of Jiang and Kessler with Jindal, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to independent claim 15 because Jiang and Kessler cannot be meaningfully combined and they all lack the feature of a database for storing a digital identity or a digital identity server coupled to the database and a command server for providing access to the digital identity data. As such, Appellants submit that dependent claims 26 and 27 are also not obvious and are patentable under 35 U.S.C. §103.

Therefore, Appellants respectfully request that this rejection under 35 U.S.C. §103(a) be withdrawn.

CONCLUSION

Thus, Appellant submits that none of the claims presently in the application are obvious under the provisions of 35 U.S.C. § 103. Consequently, Appellant believes all these claims are presently in condition for allowance.

For the reasons advanced above, Appellant respectfully urges that the rejections of claims 15-27 as being obvious under the provisions of 35 U.S.C. § 103 are improper. Reversal of the rejections of the Final Office Action is respectfully requested.

Respectfully submitted,

12/11/06

Date

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CLAIMS APPENDIX

1-14. (Cancelled)

15. (Previously presented) A system, comprising:

a database for storing a digital identity for each of at least two user devices and providing access to the digital identities, wherein one of the user devices is a DTV client;

a command server for storing a plurality of configuration information about each user device and providing access to the configuration information; and

a digital identity server coupled to the database and the command server and including at least two adapters for at least two types of user device, each adapter associated with one of the types of user devices, the adapters for storing a plurality of digital identity data associated with each digital identity, providing access to the digital identity data, and interfacing with each user device, the digital identity server configured for receiving a request from a particular user device via one of the adapters, accessing the digital identity for the particular user device from the database, accessing the configuration information about the particular user device from the command server, applying the configuration information to filter the digital identity, and providing the filtered digital identity to that user device via one of the adapters.

16. (Previously presented) The system of claim 15, wherein the digital identity includes at least one of a plurality of preferences, a plurality of favorites, a plurality of cookies, a set of applications, and a set of services.

17. (Previously presented) The system of claim 15, wherein the configuration information of each user device includes at least approximations of a processing power, a bandwidth, and a memory footprint.

18. (Previously presented) The system of claim 15, wherein the adapters include at least one of a CORBA adapter, a DTV cookie adapter, and an XML adapter.
19. (Previously presented) The system of claim 15, further comprising:
a digital identity API for the adapters.
20. (Previously presented) The system of claim 15, further comprising:
at least one additional adapter that was written using a digital identity SDK.
21. (Previously presented) The system of claim 15, wherein one of the user devices is a provisioning application that interfaces with the digital identity server via a CORBA adapter.
22. (Previously presented) The system of claim 15, wherein one of the user devices is a control console that interfaces with the digital identity server via a CORBA adapter.
23. (Previously presented) The system of claim 15, wherein the DTV client interfaces with the digital identity server via a DTV cookie adapter.
24. (Previously presented) The system of claim 15, wherein the DTV client interfaces with the digital identity server via an XML adapter.
25. (Previously presented) The system of claim 15, wherein one of the user devices is an external database that interfaces with the digital identity server via a third party plug-in, wherein the external database is the database that provides access to the digital identity to the digital identity server.
26. (Previously presented) The system of claim 15, further comprising:

a first server group including the digital identity server; and
a second server group including a second digital identity server;
wherein load balancing may be performed by having the digital identity server service any user device associated with the second server group or the second digital identity server service any user device associated with the first server group.

27. (Previously presented) The system of claim 26, wherein the first and second server groups are definable by a network operator.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None.